

## REMARKS/ARGUMENTS

The rejections presented in the Office Action dated December 19, 2007 (hereinafter Office Action) have been considered. Claims 1-50 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1, 4, 5, 9, 11, 13, 14, 16, 20, 21, 23, 25, 26, 28, 29, 35, 36 and 38-50 are rejected based on 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2004/0147270 by Petrovich (hereinafter "*Petrovich*"). The Applicants respectfully traverse the rejection in view of the following.

It is first noted that *Petrovich* is ostensibly cited as teaching that the "signs" indicated in the *Petrovich* reference teach associating a visual representation with a transponder, where the visual representation corresponds to the function(s) to be performed. The Office Action indicates that the sign may include a logo or emblem that indicates the "product/service" being offered. Claim 1, for example, indicates that the visual representation corresponds to the *function* to be performed. *Petrovich*'s logo/emblem indicates only what a product would be, which does not correspond to the function or application to be invoked. It merely provides some visual information unrelated to what application is to be invoked. Looking again to Claim 1, the Applicants respectfully submit that to the extent that the Examiner suggests that providing any relevant visual information on a tag corresponds to the function or application to be invoked, then *Petrovich* does not qualify as prior art. The priority document of the instant application (U.S. Application No. 10/180,267, filed June 26, 2002, which predates the provisional/priority date of *Petrovich*), describes that information associated with a service request can be printed visually on the RFID tag (*e.g.*, U.S. Application No. 10/180,267, page 25, lines 9-13). The priority document also indicates that RFID *stickers* can be purchased that provide configurations, profiles, wallpaper, skins, radio channels, etc. (*e.g.*, U.S. Application No. 10/180,267, page 15, lines 7-10). The other elements of Claim 1 are also supported by the original priority document (U.S. Application No. 10/180,267).

Nevertheless, in order to facilitate prosecution of the application, the Applicants have made amendments to the claims to more clearly set forth distinctions from the cited art.

Amended Claim 1 indicates each visual representation identifies at least one function to be performed by a device upon its reading of the associated transponder, invoking an application that relates to the visual representation associated with that transponder, and performing the function identified by the visual representation associated with the activated transponder in response to executing that invoked application. For some of these limitations, the Examiner relied upon *Petrovich* and *Perttila* (see pages 4 and 5 of Office Action).

However, an obviousness rejection involving *Perttila* cannot preclude patentability pursuant to 35 U.S.C. §103(c), which states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

*Perttila* could only qualify as prior art only under subsection (e) of section 102. The subject matter of *Perttila* and the subject matter of the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

More particularly, *Perttila* could only qualify as prior art under 35 U.S.C. §102(e) (assuming, *arguendo*, that the priority document of the instant application does not support at least one limitation of the rejected claims) . The subject matter of *Perttila* was described in an application for patent having a U.S. filing date prior to the (CIP) filing date of the current patent application, but was published after the CIP filing date of the present application. Thus, even assuming that *Perttila* qualified as prior art under §102(e), 35 U.S.C. §103(c) applies if the subject matter of *Perttila* and the subject matter of the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This is true in this case. The subject matter in both *Perttila* and in the present application were under an obligation to assign to Nokia Corporation at the time the present invention was made.

Accordingly, a combination of *Petrovich* and *Perttila* cannot be used in an obviousness rejection. In rejections involving the *Perttila* reference (*e.g.*, see pages 4 and 5 of Office

Action), the Examiner asserts that *Perttila* describes different service types that can be used, and that *Perttila* discloses the tag's identifier "can identify the on application on the mobile terminal that is to be activated..." (Office Action page 4, emphasis in original). Features of *Perttila* which have been relied upon have been included in Claim 1, where a rejection based on the *Petrovich/Perttila* combination cannot be applied due to 35 U.S.C. §103(c). For at least these reasons, Claim 1 is in condition for allowance.

Dependent Claims 2-11, and 12, are dependent from independent Claim 1. Claims 4, 5, 9 and 11 were rejected as being anticipated by *Petrovich*; Claims 2, 3, 6-8 and 10 were rejected as being obvious in view of the *Petrovich/Perttila* combination; and Claim 12 was rejected as being obvious in view of *Petrovich* and *MacLellan*. The Applicants respectfully traverse the rejections. Some of these claims have been amended to ensure proper antecedent basis in view of the amendment to Claim 1. These dependent claims are now in condition for allowance, for at least the following reasons.

Regarding Claims 4, 5, 9 and 11, these claims are dependent from independent Claim 1, which has been amended to include at least some features that the Office Action does not identify *Petrovich* as teaching or suggesting, nor does *Petrovich* teach/suggest these features of Claim 1, as indicated above. These features include, for example, each visual representation identifying at least one function to be performed by a device upon its reading of the associated transponder, invoking an application that relates to the visual representation associated with that transponder, and performing the function identified by the visual representation associated with the activated transponder in response to executing that invoked application. As *Perttila* is relied upon as teaching at least some of these functions, and because the *Petrovich/Perttila* combination has been properly addressed pursuant to 35 U.S.C. §103(c), amended Claim 1, and dependent Claims 4, 5, 9 and 11 are in condition for allowance. Claims 2, 3, 6-8 and 10 were rejected based on the *Petrovich/Perttila* combination, and pursuant to 35 U.S.C. §103(c) these claims are also in condition for allowance. Regarding Claim 12, the *Petrovich/MacLellan* combination at least fails to teach or suggest the limitations of amended Claim 1, to which Claim 12 is dependent. Thus, Claim 12 is also in condition for allowance.

As all of the claims subject to the *Petrovich* anticipation rejection were rejected without specificity to claim number, Independent Claim 13 was rejected on the same grounds as that of

independent Claim 1. Without acquiescence to the collective rejections to Claim 13, Claim 13 has been amended to facilitate prosecution of the application. Amended Claim 13 indicates each visual representation identifies at least one function to be performed by a device upon its reading of the associated transponder, invoking an application that relates to the visual representation associated with that transponder, and performing the function identified by the visual representation associated with the activated transponder in response to executing that invoked application. As indicated above, *Petrovich* does not teach all of these limitations, and to for features in which the Examiner relied upon *Perttila*, the combination cannot be used to establish *prima facie* obviousness due to the 35 U.S.C. §103(c) issue described above. Therefore Claim 13 is also in condition for allowance.

Some of dependent Claims 14-19 were rejected as being anticipated by *Petrovich*, and some were rejected as being rendered obvious by the *Petrovich/Perttila* combination. As indicated above, Claim 13 has been amended to include at least some features that the Office Action does not identify *Petrovich* as teaching or suggesting, nor does *Petrovich* teach/suggest these features of Claim 13. These features include, for example, each visual representation identifying at least one function to be performed by a device upon its reading of the associated transponder, invoking an application that relates to the visual representation associated with that transponder, and performing the function identified by the visual representation associated with the activated transponder in response to executing that invoked application. As *Perttila* is relied upon as teaching at least some of these functions, and because the *Petrovich/Perttila* combination has been properly addressed pursuant to 35 U.S.C. §103(c), amended Claim 13 and its dependent claims 11 are in condition for allowance. The Applicants note that amendments to those claims dependent from independent Claim 13 were made to maintain antecedent basis in view of the amendments to Claim 13.

Independent Claim 20 was rejected on the same grounds as that of independent Claim 1. The Applicants respectfully traverse the rejection. It is first noted that nothing in *Petrovich* describes identifying or selecting any type of communication function that is associated with a visually-presented identifier. Even assuming *arguendo* that *Petrovich* displays a “product” to be chosen as indicated in the rejection, there is no indication of anything relating to the type of

“communication” that is to be used, and thus any logo/emblem of *Petrovich* does not identify any *communication function*.

Further, without acquiescence to the collective rejections to Claim 20, Claim 20 has been amended to facilitate prosecution of the application. Amended Claim 20 indicates that an application activated at a device performs a communication function relating to the visually-presented communication function identifier. *Petrovich* clearly does not teach or suggest these additional limitations. Nothing in *Petrovich* describes that information on the “sign” or associated with the “dataform” indicates what communication application and/or what type of communication is to be used at a device. Therefore *Petrovich* does not anticipate amended Claim 20.

Dependent Claims 21-29 are dependent from independent Claim 20. Claims 21, 23, 25, 26, 28 and 29 were rejected as being anticipated by *Petrovich*; Claims 24 and 27 were rejected as being obvious in view of the *Petrovich/Perttila* combination; and Claim 22 was rejected as being obvious in view of *Petrovich* and *Hall*. The Applicants respectfully traverse the rejections. Some of these claims have been amended to ensure proper antecedent basis in view of the amendment to Claim 20. These dependent claims are in condition for allowance, for at least the following reasons.

Regarding Claims 21, 23, 25, 26, 28 and 29, these claims are dependent from independent Claim 20, include at least some features that the Office Action does not identify *Petrovich* as teaching or suggesting, nor does *Petrovich* teach/suggest these features of Claim 20 as indicated above. These features include, for example, identifying and selecting the type of communication function that is associated with a visually-presented identifier, and invoking an application at a device that performs a communication function relating to the visually-presented communication function identifier. As *Perttila* is relied upon as teaching at least some of these functions, and because the *Petrovich/Perttila* combination has been properly addressed pursuant to 35 U.S.C. §103(c), amended Claim 20 and dependent Claims 21, 23, 25, 26, 28 and 29 are in condition for allowance. Claims 24 and 27 were rejected based on the *Petrovich/Perttila* combination, and pursuant to 35 U.S.C. §103(c) these claims are also in condition for allowance. Regarding Claim 22, the *Petrovich/Hall* combination at least fails to

teach or suggest the limitations of amended Claim 20, to which Claim 22 is dependent. Thus, Claim 22 is also in condition for allowance.

Claims 30-34 stand rejected based on 35 U.S.C. §103(a) as being unpatentable over *Petrovich* in view of U.S. Patent No. 5,649,296 to *MacLellan*. The Applicants respectfully traverse the rejection. Without acquiescence to the rationale in the Office Action correlating *Petrovich* to the rejected claims, independent Claim 30 has been amended to facilitate prosecution of the application. The media of Claim 30 identifies a function to be performed by the device that reads the RFID tag, which is not described in the *Petrovich* reference relied upon in the Office Action, nor is it described in the *Hall* reference. Claim 30 now also indicates that the local application on the device relates to the media associated with its respective RFID tag, and the local application is executed using at least a portion of the content in order to perform a function that is identified by the media. It is respectfully submitted that neither *Petrovich* nor *Hall* teach or suggest at least these claimed features, and therefore amended Claim 30 is in condition for allowance.

Dependent Claims 31-34, which are dependent from independent Claim 30, were also rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Petrovich* and *Hall*. While the Applicants do not acquiesce with any particular rejections to these dependent claims, including any assertions concerning common knowledge, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claim 30. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious (M.P.E.P. §2143.03). Therefore, dependent Claims 31-34 are also allowable over the *Petrovich/Hall* combination.

Independent Claim 35 was rejected on the same grounds as that of independent Claim 1. The Applicants respectfully traverse the rejection. Without acquiescence to the particular rejections to Claim 35, Claim 35 has been amended to facilitate prosecution of the application. It is first noted that nothing in *Petrovich* describes any item having a visual representation that identifies an available communication function to be performed by a device upon it machine-

reading the associated transponder. Amended Claim 35 indicates that the communication function that is identified by the visual representation is the communication function that is performed when the device's processor executes the application identified by the identifier provided by the respective transponder. *Petrovich* at least fails to teach or suggest correlating any visual representations with a particular communication function(s) that will be performed by the reading device, or performing the communication function that is identified by the visual representation that is associated with the item. For at least these reasons, *Petrovich* does not anticipate amended Claim 35.

Dependent Claims 36 and 38-43, which are dependent from independent Claim 35, were also rejected under 35 U.S.C. §102(e) as being unpatentable over *Petrovich*. Amendments to some of these dependent claims were made to ensure proper antecedent basis in view of the amendments to independent Claim 35. While the Applicants do not acquiesce with the particular rejections to these dependent claims, including any assertions concerning inherency, these rejections are moot in view of the remarks made in connection with independent Claim 35. These dependent claims include all of the limitations of Claim 35 and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent Claims 36 and 38-43 are also in condition for allowance.

Dependent Claim 37 was rejected based on 35 U.S.C. §103(a) as being unpatentable over *Petrovich* in view of *MacLellan* as applied to Claim 30, and further in view of U.S. Patent No. 6,624,752 to *Klitsgaard*. The *Petrovich/MacLellan* combination is thus relied upon in the Office Action as teaching or suggesting the limitations of independent Claim 30. The Applicants' remarks above establish that independent Claim 30 is not taught or suggested by the *Petrovich/MacLellan* combination. *Klitsgaard* was not cited as describing the limitations of Claim 30 that are not taught or suggested by *Petrovich* or *MacLellan*, nor does *Klitsgaard* remedy the deficiencies of *Perttila* and *MacLellan* in this regard. As none of *Petrovich*, *MacLellan* nor *Klitsgaard* teach or suggest at least the claimed features identified above in connection with the response to independent Claim 30, a combination of *Petrovich*, *MacLellan* and *Klitsgaard* also fails to teach or suggest these claimed features. For at least these reasons, Claim 37 is not rendered obvious by the cited combination of references, as the features

claimed in amended Claim 30 are not described in the *Petrovich/MacLellan/Klitsgaard* combination.

Independent Claim 44 was rejected on the same grounds as that of independent Claim 1. The Applicants respectfully traverse the rejection. Without acquiescence to the particular rejections to Claim 44, Claim 44 has been amended to facilitate prosecution of the application. *Petrovich* at least fails to describe any item having a visual representation that identifies an available communication function to be performed by the device upon that device machine-reading the associated transponder. Amended Claim 44 indicates that the communication function that is identified by the visual representation is the communication function that is performed by that device when it processes the application identifier. *Petrovich* at least fails to teach or suggest correlating any visual representations with a particular communication function(s) that will be performed by the device, or performing the communication function that is identified by the visual representation that is identified by the item.. For at least these reasons, *Petrovich* does not anticipate amended Claim 44.

Independent Claim 45 was rejected on the same grounds as that of independent Claim 1. The Applicants respectfully traverse the rejection. Without acquiescence to the particular rejections to Claim 45, Claim 45 has been amended to facilitate prosecution of the application. *Petrovich* at least fails to describe any visual identifier that depicts a function to be performed by the device that machine-reads the transponder. In Claim 45, the memory is configured to store at least an application identifier that relates to the visually depicted function itself. Thus, the visual identifier suggests what actual function will be performed by the application itself. These features are not described in *Petrovich*, and thus Claim 45 is in condition for allowance over the *Petrovich* reference. To the extent that these functions are suggested in the *Perttila* reference, a combination of *Petrovich* and *Perttila* cannot be used in a rejection due to 35 U.S.C. §103(c) as described above. While the Applicants do not acquiesce with the particular rejections to Claims 46 and 47, these claims are dependent from independent Claim 45, and are also in condition for allowance.

Independent Claim 48 was rejected on the same grounds as that of independent Claim 1. The Applicants respectfully traverse the rejection. Without acquiescence to the particular rejections to Claim 48, Claim 48 has been amended to facilitate prosecution of the application.



*Petrovich* does not describe at least invoking a specific application in response to receiving the radio frequency signal from a transponder associated with a visual representation that identifies the particular function(s) to be performed by that apparatus upon reading the transponder.

*Petrovich*'s description of identifying a product does not provide a visual representation of what specific application will actually be involved or executed when information is obtained from the transponder associated with that visual representation. For at least these reasons, *Petrovich* does not anticipate amended Claim 48, which is now in condition for allowance. To the extent that these functions are suggested in the *Perttila* reference, a combination of *Petrovich* and *Perttila* cannot be used in a rejection due to 35 U.S.C. §103(c) as described above.

Independent Claim 49 was rejected on the same grounds as that of independent Claim 1. The Applicants respectfully traverse the rejection. Without acquiescence to the particular rejections to Claim 49, Claim 49 has been amended to facilitate prosecution of the application. *Petrovich* at least fails to describe visual representations of the *communication function* to be performed by a device(s), but rather describes a product. Further, Claim 49 involves invoking an application that is identified by the received information, and ultimately performs that communication function corresponding to the visual representation associated with the transponder. In *Petrovich*, there is no application identifier that identifies a communication application to perform the communication function identified via the visual representation. For example, if *Petrovich* indicates that a logo is "pop & cola" or "cookies," (see FIG. 13), this does not visually indicate what communication function is to be performed. For at least these reasons, amended Claim 49 is in condition for allowance. To the extent that these functions are suggested in the *Perttila* reference, a combination of *Petrovich* and *Perttila* cannot be used in a rejection due to 35 U.S.C. §103(c) as described above.

Independent Claim 50 was rejected on the same grounds as that of independent Claim 1. The Applicants respectfully traverse the rejection. Without acquiescence to the particular rejections to Claim 50, Claim 50 has been amended to facilitate prosecution of the application. *Petrovich* does not describe invoking an application that relates to a visual representation of a type of over-the-air connection. Claim 50 goes on to claim that the over-the-air connection is established where the function that is performed is identified by that visual representation that involved the type of over-the-air connection shown by the visual representation. In *Petrovich*,

visual representation of an over-the-air connection type, or any type of communication function. For at least these reasons, amended Claim 50 is in condition for allowance. To the extent that these functions are suggested in the *Perttila* reference, a combination of *Petrovich* and *Perttila* cannot be used in a rejection due to 35 U.S.C. §103(c) as described above.

It should be noted that other differences may and do exist between the claims and the *Petrovich* reference that were not specifically argued. However, all claim elements and their limitations must be found in the single prior art reference to maintain a rejection based on 35 U.S.C. §102, and establishing that any one or more such limitation(s) is missing from the prior art is sufficient to overcome a §102 rejection. The absence of arguments addressing other distinguishable points between the claimed invention and the *Petrovich* reference is not an admission by the Applicants that such other elements are described in *Petrovich*.

It should also be noted that the Applicants do not acquiesce with the motivation to combine the references identified in 35 U.S.C. §103 rejections. While the Applicant does not acquiesce that the proper motivation to combine the cited references has been established and/or the reasonable expectation of success has been established, it is respectfully submitted that *prima facie* obviousness is not established at least because the claim limitations are not taught or suggested by the cited combinations.

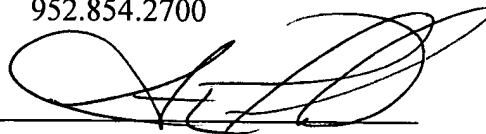
Authorization is given to charge Deposit Account No. 50-3581 (NOKV.013CIP) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC  
8009 34<sup>th</sup> Avenue South, Suite 125  
Minneapolis, MN 55425  
952.854.2700

Date: May 19, 2008

By:



Steven R. Funk  
Reg. No. 37,830